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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/928,353

08/14/2001

Naoya Suzuki

212667US6

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22850

7590

06/04/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
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EXAMINER

WALSH, JOHN B

ART UNIT

PAPER NUMBER

2151

NOTIFICATION DATE

DELIVERY MODE

06/04/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/928,353	<b>Applicant(s)</b> SUZUKI, NAOYA	
	<b>Examiner</b> John B. Walsh	<b>Art Unit</b> 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 22, 25, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,216,158 to Luo et al in view of U.S. Patent No. 5,729,220 to Russell.

Luo et al. '158 disclose: a remote controller terminal (palm sized computer; 100); an information processing device (110,120,130,140,150; column 1, lines 18-19); wherein said remote controller includes a local wireless interface (column 5, lines 57-65) configured to communicate with said information processing device, an input device (input capabilities; column 1, lines 24-25; column 6, line 1; column 7, line 18) configured to receive a request to remotely control said information processing device with said remote controller terminal (column 2, line 22), and configured to transmit information (column 2, lines 47-52; column 4, lines 42-53- information transmitted between remote terminal and device) to a processor, said information required for generating a menu operation request, a selection request and an operation determination request (col. 4, lines 40-65), said processor configured to, upon the input device receiving a request to remotely control, transmit a driving signal and an identification ID (inherent to have an "ID" for addressing data over the network) to said information processing device (column 2, lines 47-52); the information processing device includes an interface (fig. 1,

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130,140; col. 4, lines 60-65) configured to receive an input selecting a subset of a plurality of item data available at the information processing device (col. 6, lines 55-67) as the previously set item data and associate the selected previously set item data with the remote controller (col. 6, lines 1-20 and 55-67); said remote controller further comprising a display unit (figure 1; palm 100 has a screen for displaying; figure 2-GUI 212) configured to display said received previously set item data; said remote controller terminal configured to correspond said menu operation request, said selection request, and said operation determination request with said previously set item data (column 3, lines 45-46; column 1, lines 38-42); wherein said information processing device is configured to transmit requested information to said remote controller terminal after receiving said menu operation request, said selection request, and said operation determination request (column 3, lines 14-20; column 3, lines 45-48; column 3, lines 62-63).

Luo et al. '158 do not explicitly disclose wherein said information processing device is configured to respond to said driving signal and said identification ID by verifying said identification ID has access according to registered ID information, and configured to, if access is permitted, transmit to said remote controller terminal previously set item data.

Russell '220 teaches a first authentication ID to said remote controller terminal and the second control means determines that said first authentication ID is identical to a second authentication ID stored in said information processing device (figure 13A; column 14, lines 50-65; column 15, lines 20-28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Luo et al. '158 with authentication ID's in order to provide for secure transmissions of data and access.

As concerns claim 25, said operation determination request is transmitted separately from said menu operation request and said selection request (column 4, lines 42-43; requests sent at separate points of time since user has to perform requests in sequence such that one happens before the other).

As concerns claim 26, said information processing device is configured to determine whether said menu operation request as processed by said information processing device corresponds with said received selection request (column 8, lines 54-64).

As concerns claim 27, said information processing device moves through a task menu until the task menu lists a selection in accordance with said received selection request (column 6, lines 53-67; column 8, lines 55-60).

3. Claims 23, 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,216,158 to Luo et al. and U.S. Patent No. 5,729,220 to Russell as applied to claim 22 above in view of EP 0 797 336 A2.

Luo et al. '158 as modified do not explicitly disclose a jog dial as an input device.

EP '336 teaches a jog dial (6J).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the palm of Luo et al. '158 as modified with a jog dial, as taught by EP '336, in order to provide a means of selecting a desired function with one hand which also is used to hold the palm as well.

***Response to Arguments***

4. Applicant's arguments filed March 13, 2008 have been fully considered but they are not persuasive.

The applicant argues Luo fails to teach or suggest that the palm sized computer receives any data from these controlled devices (p. 6). However on p. 7 of applicant's response they acknowledge that Luo describes the palm sized computer downloads and executes code/applications. Thus Luo does receive data from the controlled devices.

The applicant argues none of the resources controlled by the palm sized computer transmit "previously set item data". The claims do not distinguish what encompasses "previously set item data" and is thus merely data. The "data" transmitted in Luo therefore satisfies "data" to be "previously set item data".

The applicant argues none of the network services to be controlled in Luo transmit data to the palm sized computer based on an ID of the computer. The computers of Luo transmit information back and forth and it is inherent for the communication of Luo's network devices to have an "ID" such that the data can be identified for each respective party.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John B. Walsh/  
Primary Examiner, Art Unit 2151